

Carl-Eric Ohlson, S.N. 09/827,380
Page 7

Dkt. 1166/61926-A

REMARKS

The application has been reviewed in light of the final Office Action dated February 9, 2005. Claims 20-28 are pending, with claims 20-24 being in independent form.

The Office Action indicates that the disclosure is objected to having informalities.

By this Amendment, the specification has been amended to include reference to FIG. 21.

Claims 20, 23, 25 and 27 were rejected under 35 U.S.C. §112, first paragraph, as purportedly failing to comply with the written description requirement. Claims 20, 23, 25 and 27 were rejected under 35 U.S.C. §251 as purportedly being based on new matter added to the patent for which reissue is sought.

The Office Action states that the original specification disclosed a filmless system in which images are produced and stored electronically. The Office Action states, however, that there is no support for a solid state detecting portion formed by plural solid-state detecting elements.

Applicant disagrees.

The original disclosure refers to EP-A-0 430 934 as relevant background art. EP-A-0 430 934 discloses use of an X-ray receptor unit comprising plural solid-state electronic X-ray receptors (a primary receptor and a secondary receptor).

One skilled in the art would have understood from the original specification that the filmless system referenced in the specification can include the X-ray receptor unit of EP-A-0 430 934.

In addition, the title and abstract of the original disclosure by themselves indicate that the methods, apparatuses and systems disclosed in the specification can include use of "electronic image storage". U.S. Patents Nos. 4,905,265, 5,319,206 and 5,661,309, which were previously

Carl-Eric Ohlson, S.N. 09/827,380
Page 8

Dkt. 1166/61926-A

brought to the Examiner's attention, are evidence of some of the many references in the art at the time the original disclosure was filed which express the understanding that electronic image storage is most often associated with use of a solid state detecting portion comprising plural solid-state detecting elements.

Accordingly, Applicant submits that there is ample support in the original disclosure for a solid state detecting portion formed by plural solid-state detecting elements.

Withdrawal of the rejection under 35 U.S.C. §112 and the rejection under 35 U.S.C. §251 is requested.

Claims 20-28 were rejected as purportedly being based on a defective reissue oath/declaration.

The Office Action states that the error which is relied upon to support the continuation reissue application cannot be identical to the error upon which a parent reissue application is based. The Office Action cites to 37 C.F.R. §1.175(e) and MPEP 1414 section II, paragraph (D).

As pointed out in the Office Action, 37 C.F.R. §1.175(e) is a new provision in the patent rules which was adopted September 21, 2004 and became effective October 21, 2004. The new provision was necessary because the patent rules did not include this restriction prior to adoption of 37 C.F.R. §1.175(e).

It should be noted that this continuation reissue application was filed April 4, 2001. The Declaration filed this application are sufficient and compliant with the patent rules at the time of filing of this reissue application, and cannot be rendered defective by a later adopted provision.

In addition, Applicant submitted a Supplemental Declaration in this application on June 30, 2004. The Supplemental Declaration also cannot be rendered defective by the later-adopted provision under 37 C.F.R. §1.175(e).

Carl-Eric Ohlson, S.N. 09/827,380
Page 9

Dkt. 1166/61926-A

MPEP 1414 section II, paragraph (D), like 37 C.F.R. §1.175(e), was adopted after the filing of this application.

Therefore, it is clear that there were no provisions in the patent rules or in the MPEP at the time this application was filed which rendered the Declaration filed with the application defective.

In addition, MPEP 1414 section II, paragraph (D) is directed to the circumstance that a copy of the Declaration from the parent reissue application is submitted as the Declaration for the continuation reissue application. Here, the Declaration filed with and for this continuation reissue application was not a copy of the Declaration from the parent reissue application. Further, a new Supplemental Declaration was submitted in this application in addition to the new Declaration filed with the continuation reissue application.

Further it is noted that the error identified in the Supplemental Declaration in this application is not the same as the error identified in the Declaration of the parent reissue application.

The Supplemental Declaration in this application states that at least one error being corrected by this application is as follows:

“The inadvertent failure to include at least one broader apparatus claim such as claim 20 and/or one broader system claim such as claim 22 ...”

In contrast, the Declaration in the parent reissue application states that at least one error corrected by the parent reissue application is as follows:

- “1. The inadvertent failure to include method claims such as proposed reissue claim 76 ...
2. The inadvertent failure to include apparatus or system claims such as proposed reissue claim 20 ...”

Carl-Eric Ohlson, S.N. 09/827,380
Page 10

Dkt. 1166/61926-A

Claims 20 and 22 of this application as filed (or currently pending) are not the same and not even similar to claim 76 or claim 20 in the parent reissue application.

Therefore, contrary to the contention in the Office Action, the error identified in the Supplemental Declaration in this application is not the same as the error identified in the Declaration of the parent reissue application.


Accordingly, it is submitted that the Declarations submitted in this application are not defective and this application is in condition for allowance.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Office is hereby authorized to charge any fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Allowance of this application is respectfully requested.

Respectfully submitted,


Paul Teng, Reg. No. 40,837
Attorney for Applicant
Cooper & Dunham LLP
Tel.: (212) 278-0400